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09/972,183	10/05/2001	Akihiko Toyoshima	50P4257.05	3119
36738	7590	03/28/2007	EXAMINER	
ROGITZ & ASSOCIATES 750 B STREET SUITE 3120 SAN DIEGO, CA 92101			TORRES, MARCOS L	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/972,183  
Filing Date: October 05, 2001  
Appellant(s): TOYOSHIMA, AKIHIKO

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John L. Rogitz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5-9-2006 appealing from the Office action  
mailed 5-08-2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6804730

Kawashima

10-2004

6615057

Petterson

9-2003

6662023                    Helle                    12-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima US006804730B1 in view of Petterson US006615057B1 further in view of Helle US006662023B1.

As to claim 26, Kawashima discloses the system for rendering difficult the use of a module with an unauthorized peripheral device (see col. 1, lines 12-15), comprising; at least one mobile module including at least one security code (see col. 10, lines 45-49); at least one peripheral device having an input device (see col. 10, lines 25-27) and a display (see col. 10, lines 27-29) and using the module only if a human user provides

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the security code to the peripheral device and the security code provided to the peripheral device matches the security code provided to the mobile module (see col. 10, lines 25-61), the peripheral device being a portable computing device (see col. 1, lines 16-24), the module being removable engage able with the peripheral device (see col. 7, lines 1-2).

Kawashima does not specifically disclose a module including a wireless transceiver. In an analogous art, Petterson discloses a module including a wireless transceiver and memory (see col. 6, lines 25-30; col. 8, lines 21-26), thereby permitting wireless data transfer. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of enabling a secure wireless transfer.

Kawashima and Petterson do not disclose using a server to deactivate the wireless module in the event that the wireless module is lost or stolen. In an analogous art, Helle discloses deactivating a module using a server in the event that the module is lost or stolen (see col. 3, lines 43-55), thereby controlling the operation of the missing device. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of avoiding fraudulent use.

Regarding claim 27 is the corresponding method claim of system claim 26. Therefore, claim 27 is rejected for the same reason shown above.

**(10) Response to Argument**

Appellant's arguments filed 5/9/2006 have been fully considered but they are not persuasive. The above grounds of rejection has been modified to clarify why the combination of Kawashima, Petterson and Helle reads on the claimed limitations, which should not be considered as a new ground rejection.

In response to appellant's argument that Helle fails to teach the limitation of "using a server to deactivate the wireless module in the event that the wireless module is lost and/or stolen" as recited in claim 1 and the limitation of "deactivating the wireless module using a server in the event that the wireless module is lost and/or stolen because Helle teaches the phone can call out to one other number and to emergency number (col. 3 lines 44-45) and nowhere does Helle teach using a server to place the phone in a secure mode as recited in page 4 of the Appeal Brief, it is noted that Helle clearly teaches to deactivate the usage of mobile (10, figure 1) in a secure mode (col. 3 lines 42-44) and to lock the mobile phone when the owner sends the control message with a phone lost/stolen instruction (col. 4 lines 5-7 and lines 24-26). In addition, Helle teaches to control the mobile phone remotely via a Short Messaging System (col. 1 lines 46-48) and transferring control message to the mobile phone via Short Messaging System (col. 5 lines 28-47), wherein the mobile phone can receive the control message when it is in contact with a network such that the control message sent by the owner would be obviously received by a Short Messaging server in the Short Messaging System, and then the Short Messaging server forwards the control message to the mobile phone when the mobile phone is in contact with the network. Thus, Helle

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teaches to utilize a server to place the phone in a secure phone in the event that the mobile phone is lost and/or stolen. Although it is correct that Helle teaches emergency calls and calls to one other number may be permitted when the usage of the mobile phone is prohibited (col. 3 lines 42-45), the claimed language fails to clearly define the deactivation of the wireless module requiring to deactivate all the function of the wireless module including of making outgoing emergency calls. Thus, the teaching of prohibiting the usage of the mobile or locking the mobile phone in the event that the mobile phone is lost and/or stolen as cited in Helle can broadly read on the claimed limitations. Furthermore, it is known in the art that all mobile phones are required by FCC to provide emergency service even though being deactivated by service providers since 1997, thereby the exception of making emergency call when the mobile phone is locked or prohibited in usage cannot be considered as limited use. As stated above, the combination of Kawashima, Pettersson and Helle teaches the claimed limitations as recited in claims 26 and 27.

In response to applicant's arguments against the references individually, i.e., Helle merely places a phone in a secure mode without giving any hint whatsoever about doing something to a wireless module that might be associated with a computer, much less does Helle motivate the specific action related to the wireless module that is recited in claims 26 and 27, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It appears that the use of Helle merely for teaching to

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use a server to deactivate the wireless module in the event that the wireless module is lost and/or stolen. Note the combination of Kawashima and Pettersson teaches all the claimed limitations except of using a server to deactivate the wireless module in the event that the wireless module is lost and/or stolen, and Helle teaches to provide a security and control modules within a mobile phone, which read as a wireless module, for receiving control message though a network via a SMS system including a SMS server to deactivate or lock the mobile phone remotely (col. 4 lines 5-39 and col. 5 lines 28-52), in order to provide user friendly by controlling the mobile phone remotely when the mobile phone has been lost or stolen (col. 1 lines 46-48). Thus, the combination of Kawashima, Pettersson and Helle teaches the claimed limitations as recited in claims 26 and 27.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kawashima and Pettersson are combinable because they are on the same field of endeavor. For example, Kawashima teaches the structure of a mobile module, i.e., a memory card (1, figure 1) having a security code and a peripheral device (2, figure 1), i.e., a portable information terminal (col. 1 lines 17-19), having an input device (col. 10 lines 25-27) and

a display (col. 10 lines 27-29) and communicate with the mobile module only if a human user provides the security code to the peripheral device and the security code provided to the peripheral device matches the security code provided to the mobile module (col. 10 lines 25-61) such that the mobile module is removably engageable with the peripheral device (col. 6 lines 63-67). Kawashima differs from the claimed invention in not specifically teaching the mobile module being a wireless module including a wireless transceiver. However, Pettersson teaches a subscriber identity module (201a, figure 3) being a wireless module (303, figure 3) having a transceiver (304, figure 3) for verifying of a user of a wireless terminal (403, figure 4), wherein the subscribe identity module is implemented as a memory card having a ROM, RAM and EEPROM and operated as a mobile module (col. 1 lines 39-46 and col. 5 line 60 through col. 6 line 29), thereby providing mobility of the mobile module by providing a local wireless communication link to communicate the mobile module related data with a terminal wirelessly (see Pettersson, col. 2 lines 57-65). The cited portions of Pettersson motivate one to provide a wireless module including a wireless transceiver in a memory card type module as recited in claims. Furthermore, the combination of Kawashima and Pettersson teaches differs from the claimed invention in not specifically teaching of using a server to deactivate the wireless module in the event that the wireless module is lost and/or stolen. Although Helle does not suggest that it may be useful for PCMCIA card of the primary reference (Kawashima), the use of Helle is merely for teaching the technique of using a server to deactivate the wireless module, i.e., a mobile station, in the event that the wireless module is lost and/or stolen (col. 4 lines 5-39 and col. 5 lines 28-52), in

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order to provide user friendly by controlling the mobile phone remotely when the mobile phone has been lost or stolen (col. 1 lines 46-48). Note the rejection, as well as the above response, clearly explains why the modification is desirable and the references are properly combinable. Therefore, claims 26 and 27 are obviously rejected by the combination of Kawashima, Pettersson and Helle.

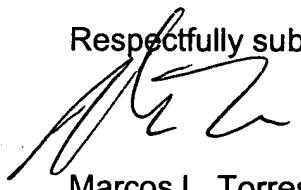
For the above reasons, the examiner respectfully submits that a prima facie case of obviousness of the claimed invention has been set forth in the Final Office action and appellants have failed to overcome the prima facie case of obviousness. Accordingly, it is believed that the final rejection under 35 U.S.C. § 103 is proper and the Board of Patent Appeals and Interference is therefore respectfully urged to sustain the Examiner's rejection.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Marcos L. Torres

Conferees:

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George Eng

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER

Duc Nguyen

  
DUC M. NGUYEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600